



New Atty. Dkt. No. 034536-0155
Old Atty. Dkt. No. 038602-1060

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Narmada SHENOY et al.

Title: FORMULATIONS FOR PHARMACEUTICAL AGENTS IONIZABLE AS
FREE ACIDS OR FREE BASES

Appl. No.: 09/716,332

Filing Date: 11/21/2000

Examiner: Dwayne C. Jones

Art Unit: 1614

Allowed: 12/24/2003

**REQUEST FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT UNDER 37 CFR §1.705(b)**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants respectfully request reconsideration of the patent term adjustment included with the Notice of Allowance mailed December 24, 2003.

The above-identified application was filed on November 21, 2000. The United States Patent Office has an obligation to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a), in accordance with 37 CFR § 1.702. The Patent Office failed to act in a timely fashion on the application, as a Restriction Requirement was not mailed to the Applicants until January 31, 2002. Therefore, patent term adjustment is needed for the time period beginning January 21, 2002, 14 months from application filing date, and January 31, 2002, the mailing date of the Restriction Requirement, a total of 10 days.

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The Patent Office mailed a non-final Office Action on June 6, 2002, which the Applicants did not respond to until December 6, 2002. This is an Applicant delay of 91 days. Applicants caused another delay of 2 days by responding to a non-final Office Action mailed July 18, 2003 on October 20, 2003.

The "Determination of Patent Term Adjustment under 35 U.S.C. 154(b)" mailed with the Notice of Allowance on December 24, 2003 states that:

"If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 0 days."

It is the Applicants' understanding that this statement is incorrect, and 37 CFR 1.705 makes it clear that any request for reconsideration of such patent term adjustment that will be accrued up to the projected grant date has to be made before the issue fee is paid. After the issue fee is paid, request for reconsideration can only be filed under 37 CFR 1.705(d) if "the patent is issued on a date other than the projected date of issue and *this change* necessitates a revision of the patent term adjustment".

The applicant believes that if the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on July 6, 2004, the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of the Notice of Allowance, the Patent Term Adjustment will be 228 days.

The applicant should receive Patent Term Adjustment under 35 U.S.C. 154(b)(1)(B), which guarantees the issuance of a patent within three (3) years from the filing date of the application. The three (3) year time period started on November 21, 2003. The projected patent grant date for this application is July 6, 2004 (28 weeks after the mailing date of the notice). If the Patent issues on the date specified in the Determination of Patent Term Adjustment, the Patent Office will have caused a delay of 228 days.

The pending application is not subject to a terminal disclaimer.

It is respectfully requested that a patent term adjustment of 145 days be issued in favor of the Applicants.

A check for the amount of \$200 is enclosed herewith. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date

3/24/04

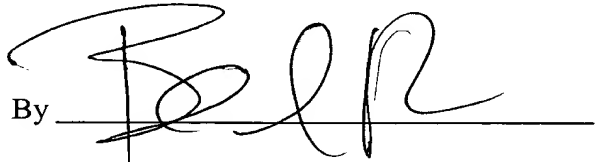
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By



Beth A. Burrous

Attorney for Applicant

Registration No. 35,087



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ISSUE FEE TRANSMITTAL

Mail Stop ISSUE FEE
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

Enclosed herewith please find the following:

- Issue Fee Transmittal Form PTOL-85(B) (1 p. in duplicate)
- Request for Reconsideration of Patent Term Adjustment (3 pp.)
- Check No. 34004 in the amount of \$1330.00 for payment of issue fee
- Check No. 34005 in the amount of \$200.00 for payment of request for reconsideration of patent term adjustment

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.18, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date 3/24/04

By

A handwritten signature in dark ink, appearing to read 'B. Burrous', written over a horizontal line.

FOLEY & LARDNER

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Beth A. Burrous

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